

REMARKS

Reconsideration of this application is respectfully requested.

This application has been reviewed in light of the Office Action dated September 7, 2006. Claims 1-5, 8-14 and 17-19 are currently pending in the application. Claims 1, 8, 14 and 19 have been amended. Support for these amendments is provided at least in paragraphs 0047, 0049, 0077-0086, 0091-0095, 0104, 0112, 0121, and 0131.

Claims 1-5, 8-14 and 17-19 were rejected under 35 USC 103(a) as being unpatentable over Lee (US 7,016,851) in view of the USPTO's "Trademark/Service Mark Application, Principal Register, with Declaration", 08/22/00, pp.11 (hereinafter "TEAS") in further view of "Frequently Asked Questions About Trademarks", 02/11/00, pp. 1-42 (hereafter "FAQ") as set forth on pages 2-15 of the Office Action dated September 7, 2006.

In regards to Claim 1, the Examiner asserted "Lee teaches a process for registering a trademark by means of a local computer (Fig. 2:221) connected to a remote computer (Fig. 2:231, 234, 241, 253, etc) via a computer Internet network (column 7, lines 40-41 and 61-62) performing the following steps in order: entering the trademark ...; sending the validated entry and selection...; and retransmitted the validated entry and selection..". The Examiner goes on to state: "Lee does not specifically teach selecting at least one displayed heading of at least one official class of products or services to which the trademark applies ...". The Examiner then asserted "TEAS teaches selecting the products or services (i.e. user could enter known Goods and/or services) to which the trademark applies from at least one of an official class (Page 4: "International Class" and "Listing of Goods and/or Services") and validating the entry and selection (Page 8: "Validate Form"). TEAS also teaches wherein the corresponding number of the at least one official class could be displayed in the trademark

registration application (Page 4: i.e. user could enter known corresponding class in the “international Class” entry box in the application”). It would have been obvious to one of ordinary skill in the art at the time of the invention for the workstation of the user (Fig. 2:221) transmitting the trademark filing documents (Column 10, lines 59-65) to have utilized the TEAS system, because Lee teaches that with regard to trademark applications the TEAS system provides the benefit of an electronic filing of a completed trademark application form over the internet directly to the USPTO (column 3, lines 15-23)”.

Furthermore, the Examiner asserted: “[n]either Lee nor TEAS specifically teaches selecting one displayed heading of official class of products. FAQ teaches that a user utilizing the TEAS system could select the “Listing of Goods and/or Services” link (page 4) and retrieve the FAQ page from which a user could select one of a displayed heading of an official class of products”.

Lee is directed to an intellectual property filing portal which facilitates selection, by applicants (or representatives), of particular jurisdictions and associates based at least in part on fee quotations in accordance with particulars of an intellectual property filing and in accordance with fee structures of the particular jurisdictions and foreign associates. In addition, the intellectual property filing portal facilitates registration of associate- and jurisdiction-specific form documents and fee schedules for at least partially automated preparation of formal documents. Illustrations are provided in the context of a patent application filing. Although Lee discloses that “the present invention may be configured to support other intellectual property filings (e.g., to secure trademarks or copyrights)”, no description for filing a trademark registration application is provided (see col. 12, lines 25-31 of US 7,016,851).

TEAS is directed to electronic filing of trademark applications provided by the United States Patent and Trademark Office (USPTO). Pages 1-9 of the TEAS reference cited by the Examiner shows a Trademark/Service Mark Application located at teas.uspto.gov/V1.22/TMS1FORM.htm on the USPTO website. Pages 10 and 11 of the cited TEAS reference appears to be a search engine for the Trademark Acceptable Identification of Goods and Services Manual located at www.uspto.gov/web/offices/tac/doc/gsanu..., located on a different portion of the USPTO's website. Furthermore, the FAQ reference lists the headings and classes of the International Classes for Goods and Services which again is located on a different portion of the USPTO's website from the application.

Claim 1 of the instant application is directed to a process "for preparing a trademark registration application to filed at a national administrative department responsible for examining the application" including the steps of, inter alia, "(i) entering the trademark to be filed at the national administrative department in a trademark registration application displayed on the local computer, (ii) selecting from the displayed trademark registration application at least one displayed heading of at least one official class of products or services to which the trademark applies and displaying a corresponding number of the selected at least one official class in the trademark registration application, (iii) validating the entry and the selection, (iv) sending the validated entry and selection to the remote computer via the computer network, the remote computer being disposed on a premises of an intellectual property attorney for reviewing the trademark registration application, (v) retransmitting the validated entry and selection from the premises of the intellectual property attorney to another remote computer to enable the application to be prosecuted at the national administrative department, said steps being carried out in the order indicated" (emphasis added). The

process of Claim 1 facilitates the preparation of a trademark application by allowing an applicant to select products or services from known official classes of products and services right in the application. By “selecting from the displayed trademark registration application at least one displayed heading of at least one official class”, the process of Claim 1 will enable the applicant to select products or services that should be accepted by the national administrative departments, e.g., corresponding trademark offices, responsible for examining the trademark applications with a view to nationally or internationally registering the trademark in the application. The process of Claim 1 will then “display[ing] a corresponding number of the selected at least one official class in the trademark registration application” thus completing two of the more difficult entries of the trademark registration application (see instant application paragraph [0008]). The applicant of the trademark application will then send the validated entry of the trademark and selection of goods and services and corresponding official class number to a remote computer of an intellectual property attorney for review, who will then transmit the application to the national administrative department. By having the applicant select from the trademark registration application at least one heading of an official class and causing the corresponding class number to be displayed in the trademark registration application, the process of Claim 1 will eliminate the need for the applicant to jump around to several different sources of information, e.g., different portions of a web site, to collect the necessary information to complete a trademark application.

Neither the Lee nor TEAS nor FAQ disclose “selecting from the displayed trademark registration application at least one displayed heading of at least one official class of products or services to which the trademark applies and displaying a corresponding number of the selected at least one official class in the trademark registration application” as

recited in Claim 1. Lee does not provide any detail on how to file a trademark registration application. The Examiner asserted "TEAS teaches selecting the products or services (i.e. user could enter known Goods and/or services) ... TEAS also teaches wherein the corresponding number of the at least one official class could be displayed in the trademark registration application (Page 4: i.e. user could enter known corresponding class in the "international Class" entry box in the application)" and FAQ merely teaches the official heading and numbers for different classes of goods and/or services. There is no suggestion or teaching in any combination of the references that allows the selecting of a heading of an official class from the application and subsequently displaying the corresponding class number in the application. The combination of cited references teaches manually entry of information into the trademark application from sources outside of the displayed trademark registration application.

Therefore, it is respectfully submitted that Claim 1, along with dependent claims 2-5, 8-13 and 17, is patentably distinct and not rendered obvious over Lee in view of the TEAS reference in further view of the FAQ reference.

Similarly, Claim 19 is directed to a process "for preparing a trademark registration application to filed at a national administrative department responsible for examining the application" including the steps of, inter alia, "(ii) selecting from the displayed trademark registration application at least one displayed number of at least one official class of products or services to which the trademark applies and displaying a corresponding heading of the selected at least one official class in the trademark registration application" (emphasis added). On page 4 of the TEAS reference, a user can enter an International Class number, not select from the trademark application a displayed number of at least one official

class, but that entry will not result in the heading of the official class being displayed in the trademark registration application. There is no where on page 4 that allows the selecting from the application of a number of at least one official class and subsequently displaying the corresponding heading of the official class in the trademark registration application. Furthermore, page 10-11 of the TEAS reference shows a result set after entering a proposed good or service in the Trademark Acceptable Identification of Goods and Services Manual not the subject trademark application. The result set includes acceptable goods along with the corresponding International Class number. Neither the class number nor suggested goods are selectable which would enter them into the trademark registration application. Therefore, it is respectfully submitted that Claim 19 is patentably distinct and not rendered obvious over Lee in view of the TEAS reference in further view of the FAQ reference.

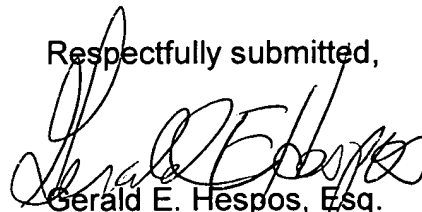
In regard to Claim 14, the Examiner asserted "Lee does not teach entering in the application at least one freely chosen wording for describing the products or services to which the trademark applies and comparing said freely chosen wording with potential wordings contained in a file of at least one official class of products and services; selecting at least one wording from among the displayed wordings proposed and entering the selected wordings in the trademark application; displaying the number of the official class corresponding to the wordings selected in the trademark registration application; and validating the entry and the selection". The Examiner then asserted TEAS teaches these features on page 10 and 11 of the TEAS reference (see page 9 and 10 of the Office Action dated April 5, 2006).

Claim 14 is directed to a process “for preparing a trademark registration application to filed at a national administrative department responsible for examining the application” including the steps of, inter alia, “(ii) entering in the application at least one freely chosen wording for describing the products or services to which the trademark applies, (iii) comparing said freely chosen wording with potential wordings contained in a file of at least one official class of products and services, (iv) displaying in the application proposed wordings from among the potential wordings, (v) selecting from the displayed application at least one wording from among the displayed proposed wordings and entering the selected wordings in the trademark registration application, (vi) displaying in the trademark registration application a number of the official class corresponding to the wordings selected, (vii) validating the entry and the selection”(emphasis added). The process of Claim 14 facilitates preparation of a trademark registration application by providing the applicant with proposed wordings for goods and services associated to the trademark. The process further facilitates preparing the trademark registration application by displaying wordings to a user in the application and then entering the wordings in the application selected by the applicant via the local computer, i.e., the entry and selection steps are all completed while the applicant is in the application. Page 10 and 11 of the TEAS reference illustrates a separate web page of the USPTO’s website and is not part of the trademark application form shown on page 4 of the TEAS reference. In practice, a user would go to the Trademark Acceptable Identification of Goods and Service Manual web page, shown in the reference at page 10, and enter a good or service. A listing of acceptable goods or services would result as shown on page 11 of the TEAS reference. The user would then choose an acceptable good or service from the list and then either write it down, memorize it or cut and paste the choice into the trademark application form shown on

page 4 of the TEAS reference, that is, the user can not select a choice from the application and have it automatically transferred to the application. Neither Lee nor the TEAS reference disclose or suggest "entering in the application at least one freely chosen wording" and "selecting from the displayed application at least one wording from among the displayed proposed wordings and entering the selected wordings in the trademark registration application" as recited by Claim 14. Furthermore, neither Lee or the TEAS reference suggest or disclose "displaying in the trademark registration application a number of the official class corresponding to the wordings selected". Therefore, it is respectfully submitted that Claim 14, along with dependent claim 17, is patentably distinct and not rendered obvious over Lee in view of the TEAS reference.

In view of the preceding amendments and remarks, it is respectfully submitted that all pending claims, namely claims 1-5, 8-14 and 17-19 are in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicants' attorney at the number given below.

Respectfully submitted,



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